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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,960	04/17/2000	Richard C. Levine	065581.0105	1648
7590	02/24/2004		EXAMINER	
Baker Botts LLP 2001 Ross Avenue Dallas, TX 75201			WOO, RICHARD SUKYOON	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/550,960	LEVINE, RICHARD C.
	Examiner Richard Woo	Art Unit 3629 <i>MW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-168 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 128-154 is/are allowed.
- 6) Claim(s) 1-127, 155-168 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

- 1) Applicant's response filed November 14, 2003 is acknowledged.

Applicant's arguments, with respect to section 103 rejections have been fully considered and are persuasive. The rejections of the previous office action have been withdrawn.

In response to Applicant's argument that produce a useful, concrete, and tangible result and directed to various methods of routing an object in a transportation network that include a number of limitations, the examiner respectfully traverses the argument for the reasons as follows:

- Although the Applicant submits that the invention is directed to various methods of routing an object in a transportation network, only the preamble of the claim merely recites this limitation and the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Notwithstanding a statement of intended use carries some patentable weight in a method claim, the claimed invention lacks patentable utility because there is not technological step involved in the claimed invention. The invention merely describes 'routing an object' or delivering the object (e.g. mail or parcel) in association with a corresponding address and code, which could be possibly done with a conventional

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delivery system (a manual activity can accomplish the same delivery or routing result).

Ex parte Bowman, 61 USPQ 2d 1669 (BdPatApp&Int 2001).

The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

- In the instant application the claimed invention is not within the technological arts – i.e., ***no computer implementation or any other technology employed.***
- 2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

- 3) Claims 1-38, 77-127 and 155-168 are rejected under 35 U.S.C. 101 because the claimed invention the claimed invention is directed to non-statutory subject matter. See

the reasons as recited earlier in the response to arguments. See Claim 128 of the instant application to see how the applicant has claimed the invention within the technological arts so as to overcome the section 101 rejections.

Claim Rejections - 35 USC § 112

4) Claims 39-100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 39, line 5, it is indefinite that that the data base alone can be operable to store, receive, determine and send the various data to route an object in a transportation network. Without being coupled to a processor, the data base itself cannot be operable to perform the claimed invention. See Claim 128 of this instant application, for example, how the apparatus can be operable to perform the claimed invention by coupling the processor to the data base.

In Claim 77, lines 7-8, the recitation of "the third address" lacks antecedent basis.

Allowable Subject Matter

5) Claims 128-154 are allowed.

Conclusion

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-

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7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Richard Woo
Richard Woo
Patent Examiner
GAU 3629
February 23, 2004

John G. Weiss
JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600